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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                 | CONFIRMATION NO.       |
|--|-------------|----------------------|-------------------------------------|------------------------|
| 10/626,596   | 07/25/2003  | Yuzhong Shen         | Q76612                              | 9765                   |
| 23373 7590 04/30/2008<br>SUGHRUE MION, PLLC<br>2100 PENNSYLVANIA AVENUE, N.W.<br>SUITE 800<br>WASHINGTON, DC 20037 |             |                      | EXAMINER<br>VIANA DI PRISCO, GERMAN |                        |
|  |             |                      | ART UNIT<br>2617                    | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>04/30/2008             | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/626,596

**Applicant(s)**

SHEN ET AL.

**Examiner**

GERMAN VIANA DI PRISCO

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Action is in response to Applicant's amendment filed on January 31, 2008. **Claims 1-3 and 8-11** are now pending in the present application. **This Action is made FINAL.**

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(e) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al (United States Patent Application Publication No.: US 2003/0219103 A1) in view of Koch (United States Patent No.: US 7,127,400 B2), and further in view of Woolston et al (United States Patent No.: US 6,856,967 B1).

Consider claims 1 and 3, Rao et al disclose a first server (soft switch 100 in figures 5 and 7) that detects information in the signaling information being transmitted between two Internet Protocol parties (paragraph [0072]) and to generate instructions out of the detected signaling information for instructing a second server (edge router 710,720) to create channels (bearer paths 350 and 360 in figure 5 and their equivalent in figure 7) to bypass a media stream to be intercepted (paragraphs [0074]-[0079]) via an intermediate storage medium (inherently taught by delivery function 160).

However Rao et al do not explicitly disclose that the soft switch 100 comprises a Session Initiation Protocol proxy server or a Media Gateway Controller or that the edge router comprises a Real-time Protocol proxy server.

In the same field of endeavor Koch discloses a media gateway controller as an element of a soft switch (column 7, lines 2-8).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a media gateway controller in a soft switch as disclosed by Koch et al in the system of Rao et al in order to process signaling information.

Nonetheless Rao et al as modified by Koch does not explicitly disclose that the edge router incorporates a Real-time Protocol proxy server.

In the same field of endeavor Woolston et al disclose a system wherein a Real-time Protocol (RTP) server may be incorporated into a router (column 12, lines 66-67).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a Real-time Protocol (RTP) server in a router as disclosed by Woolston et al in the system of Rao et al in order to transport voice/video data packets.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al (United States Patent Application Publication No.: US 2003/0219103 A1) in view of Hackbarth et al (United States Patent Application Publication No.: US 2002/0147777 A1), and further in view of Woolston et al (United States Patent No.: US 6,856,967 B1).

Consider claim 2 Rao et al disclose a first server (soft switch 100 in figures 5 and 7) that detects information in the signaling information being transmitted between two Internet Protocol parties (paragraph [0072]) and to generate instructions out of the detected signaling information for instructing a second server (edge router 710,720) to create channels (bearer paths 350 and 360 in figure 5 and their equivalent in figure 7) to bypass a media stream to be intercepted (paragraphs [0074]-[0079]) via an intermediate storage medium (inherently taught by delivery function 160).

However Rao et al do not explicitly disclose that the soft switch 100 comprises a Session Initiation Protocol proxy server or that the edge router comprises a Real-time Protocol proxy server.

In the same field of endeavor Hackbarth et al discloses a Session Initiation Protocol

proxy server as an element of a soft switch (paragraph [0044]).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a media gateway controller in a soft switch as disclosed by Hackbarth et al in the system of Rao et al in order to process signaling information.

Nonetheless Rao et al as modified by Hackbarth et al does not explicitly disclose that the edge router incorporates a Real-time Protocol proxy server.

In the same field of endeavor Woolston et al disclose a system wherein a Real-time Protocol (RTP) server may be incorporated into a router (column 12, lines 66-67).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a Real-time Protocol (RTP) server in a router as disclosed by Woolston et al in the system of Rao et al in order to transport voice/video data packets.

Claims 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al (United States Patent Application Publication No.: US 2003/0219103 A1) in view of Straut et al (United States Patent No.: US 7,219,138 B2).

Consider claim 8, Rao et al disclose a first server (soft switch 100 in figures 5 and 7) detecting information (signaling information) in the first data stream and generating an instruction (instructing edge routers 710,720) based on said information, a second server (edge router 710,720) creating a channel based (to create bearer paths) on said generated instruction, wherein said channel bypasses said first data stream through a storage device (the data is

duplicated by edge routers 710,720 and is sent to the delivery function 160, essentially creating a bypass route), and said storage device operates to store a copy of said first data stream.

Even though it would be obvious to store a copy of the intercepted data to be used by law enforcement, Rao et al do not explicitly disclose a storage device storing a copy of the data stream.

In the same field of endeavor Straut et al disclose a storage device that operates to store a copy the data stream (column 1, lines 55-65).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a storage device to store a copy of the intercepted data as disclosed by Straut et al in the system of Rao et al in order to analyze the intercepted data.

Consider claim 11, and as applied to claim 8 above, Rao et al as modified by Straut et al disclose a second server further creating a second channel (bearer path 360 in figure 5 and its equivalent in figure 7)(paragraphs [0078] and ([0079]) based on said generated instruction, wherein said second channel bypasses a second data stream (data from subscriber B), transmitted in the opposite direction as the first data stream, through the storage device, and said storage device operates to store a copy of said second data stream.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al (United States Patent Application Publication No.: US 2003/0219103 A1) in view of Straut et al (United States Patent No.: US 7,219,138 B2), as applied to claim 8 above, and further in view of Koch (United States Patent No.: US 7,127,400 B2).

Consider claim 9, and as applied to claim 8 above, Rao et al as modified by Straut et al disclose the claimed invention but does not explicitly disclose that the first server (soft switch 100) is one of a Session Initiated Protocol proxy server and a Media Gateway Controller.

In the same field of endeavor Koch discloses a media gateway controller as an element of a soft switch (column 7, lines 2-8).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a media gateway controller in a soft switch as disclosed by Koch in the system of Rao et al as modified by Straut et al in order to process signaling information.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al (United States Patent Application Publication No.: US 2003/0219103 A1) in view of Straut et al (United States Patent No.: US 7,219,138 B2), as applied to claim 8 above, and further in view of Woolston et al (United States Patent No.: US 6,856,967 B1).

Consider claim 10, and as applied to claim 8 above, Rao et al as modified by Straut et al disclose the claimed invention but does not explicitly disclose that the second server is a Real-time Transport Protocol proxy server.

In the same field of endeavor Woolston et al discloses a system wherein a Real-time Protocol (RTP) server may be incorporated into a router (column 12, lines 66-67).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a Real-time Protocol (RTP) server in a router as disclosed



by Woolston et al in the system of Rao et al as modified by Straut et al in order to transport voice/video data packets.

### ***Response to Arguments***

Applicants' arguments filed 01/31/2008 have been fully considered but they are not persuasive. The Applicants' basically argue that the soft switch in Rao does not detect information in signaling information between two IP parties and that it does not generate instructions out of the detected signaling information in order to bypass a media stream.

The Examiner respectfully disagrees. Rao clearly shows in figures 1, 5 and 7, a soft switch with arrows indicating receiving and transmitting information using signaling protocols such as MGCP, SIP and H.248. Therefore the soft switch in Rao does detect and generate signaling information. In paragraph [0019] Rao further discloses that the soft switch may provide instructions its instructions to components of the telecommunications system such as the various gateways using MGCP or H.248 or extensions of an existing protocol or an entirely new protocol.

Further, in paragraph [0072], the call interception process is explained referring to figure 6. When subscriber A places a call, the soft switch identifies subscriber A as an intercept subject. In order for the soft switch to make that determination it must detect and use signaling information, at the very least the calling number, in order to compare it against the numbers in the database.

The Applicants also argue that in Rao the media stream is not bypassed. The Examiner respectfully disagrees with the Applicants' argument because even though Rao calls it

duplicating the media stream, a new route is created, one that diverts the same intercepted media stream data to the delivery function and the law enforcement agencies while the original media stream is kept between subscriber A and subscriber B. This functionality is essentially the same as in the present application (see figure 2).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Hand-delivered responses** should be brought to

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERMAN VIANA DI PRISCO whose telephone number is (571)270-1781. The examiner can normally be reached on Monday through Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/German Viana Di Prisco/  
Examiner, Art Unit 2617  
April 17, 2008

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/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617